

REMARKS

At the time of the First Office Action dated June 17, 2008, claims 1, 7, and 13 were pending and rejected in this application.

CLAIMS 1, 7, AND 13 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BAHL, U.S. PATENT NO. 6,957,276, IN VIEW OF SATO ET AL., U.S. PATENT NO. 7,047,314 (HEREINAFTER SATO)

On pages 2 and 3 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been realistically impelled to modify Bahl in view of Sato to arrive at the claimed invention. This rejection is respectfully traversed.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."¹ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.² "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."³

To properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed

¹ In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

² KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

³ Id. (quoting Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)).

1 and the teachings of the applied prior art. Moreover, before making a proper comparison
2 between the claimed invention and the prior art, the language of the claims must first be properly
3 construed.⁴ This burden has not been met.

4
5 As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki
6 Co.,⁵ a clear and complete prosecution file record is important in that "[p]rosecution history
7 estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO
8 during the application process." The Courts that are in a position to review the rejections set
9 forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit,
10 and the Supreme Court) can only review what has been written in the record; and therefore, the
11 Examiner must clearly set forth the rationale for the rejection and clearly and particularly point
12 out those elements within the applied prior art being relied upon by the Examiner in the
13 statement of the rejection.

14
15 This requirement that the Examiner clearly set forth the rationale for the rejection and
16 clearly and particularly point out those elements within the applied prior art being relied upon by
17 the Examiner in the statement of the rejection is found in with 37 C.F.R. § 1.104(c), which reads:

18 In rejecting claims for want of novelty or for obviousness, the examiner must cite the best
19 references at his or her command. When a reference is complex or shows or describes inventions
20 other than that claimed by the applicant, the particular part relied on must be designated as nearly
21 as practicable. The pertinence of each reference, if not apparent, must be clearly explained and
22 each rejected claim specified.
23

⁴ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁵ 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

Moreover, in the unpublished opinion of Ex parte Pryor⁶, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Despite the very specific requirement for the Examiner to clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner, the Examiner has failed to do so. Instead, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the entire claim is disclosed by certain specified passages within Bahl. For example, the entirety of the Examiner's analysis regarding Bahl simply refers to column 13, lines 56-67. Thus, the manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Bahl being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Bahl being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage or an entire

⁶ Appeal No. 1997-2981.

1 paragraph to disclose a single (or multiple) claimed elements does not designate, "as nearly as
2 practicable," the particular features within Bahl being relied upon by the Examiner in the
3 rejection.

4
5 The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is also further
6 evident in M.P.E.P. § 706.07, which states:

7 The examiner should never lose sight of the fact that in every case the applicant is entitled to a full
8 and fair hearing, and that a clear issue between applicant and examiner should be developed, if
9 possible, before appeal.

10
11 A clear issue, however, cannot be developed between Applicants and the Examiner where the
12 basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis"
13 provides little insight as to (i) how the Examiner is interpreting the elements of the claims and
14 (ii) what specific features within Bahl the Examiner believes identically discloses the specific
15 elements (and interactions between elements) recited in the claims. By failing to specifically
16 identify those features within Bahl being relied upon in the rejection, the Examiner has
17 essentially forced Applicants to engage in mind reading and/or guessing to determine how the
18 Examiner is interpreting the elements of the claims and what specific features within Bahl the
19 Examiner believes identically disclose the claimed invention.

20
21 Notwithstanding the lack of specificity in the Examiner's rejection, Applicants have
22 reviewed, in detail, the Examiner's cited passage within Bahl of column 13, lines 56-67, which is
23 reproduced below:

24 To minimize the possibility of such an address conflict, one embodiment of the DHCP
25 server performs conflict detection before assigning an address. Likewise, a DHCP client may
26 perform conflict detection through the generation of gratuitous ARPs upon getting a new IP
27 address. In this way, once it discovers the conflict, the DHCP client can send a DHCP DECLINE
28 packet to the DHCP server, thus informing it of the conflict. The DHCP server then marks the
29 address as BAD and the administrator is alerted through an alerting mechanism such as discussed

1 in the RFC2131. After sending the DECLINE packet, the client enters the INIT state in order to
2 request a different address.
3

4 Entirely absent from this cited passage is a discussion of the originating network and a target
5 network. Also absent from this cited passage is a discussion of the a first address associated with
6 the originating network and a second address associated with the target address. Applicants have
7 also been unable to determine the precise teaching that corresponds to the claimed pool of pre-
8 defined addresses. Applicants, therefore, respectfully submit that the Examiner has failed to
9 properly characterize the scope and teachings of Bahl. Therefore, even if one having ordinary
10 skill in the art were motivated to modify Bahl in view of Sato, the claimed invention would not
11 result.
12

13 For above-described reasons, the Examiner has failed to establish a prima facie case of
14 obviousness in rejection claims 1, 7, and 13 under 35 U.S.C. § 103. Applicants, therefore,
15 respectfully solicit withdrawal of the imposed rejection of claims 1, 7, and 13 under 35 U.S.C. § 103
16 for obviousness based upon Bahl in view of Sato.
17

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 21, 2008

Respectfully submitted,

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